

REMARKS/ARGUMENTS

Status of the Claims

Before this Amendment, claims 1 and 35-39 were present for examination. Claims 1 and 36 are amended. No claims are canceled; and no new claims are added. Therefore, claims 1 and 35-39 are present for examination, and claims 1 and 36 are the independent claims. No new matter is added by these amendments. Applicants respectfully requests reconsideration of this application as amended.

The Office Action dated April 19, 2011 ("Office Action") rejected claims 1 and 35-39 under 35 U.S.C. §103(a) as being unpatentable over the cited portions of Takahashi U.S. Patent No. 6,483,983 ("Takahashi"), in view of the cited portions of Duhault, U.S. Patent No. 5,900,868 ("Duhault") and the cited portions of Vaidyanathan, U.S. Patent No. 6,467,081 ("Vaidyanathan").

Applicants respectfully request reconsideration for the reasons that follow.

35 U.S.C. §103(a) Rejections, Takahashi et al.

The Office Action rejected independent claims 1 and 36 under 35 U.S.C. §103(a) as being unpatentable over Takahashi, in view of Duhault and Vaidyanathan.

Factual findings made by the Office are the "necessary underpinnings to establish obviousness." MPEP §2141(II). The Office must set forth "the relevant teachings of the prior art relied upon." MPEP §706.02(j). Additionally, in *KSR* the Supreme Court noted that the analysis supporting a rejection under 35 U.S.C. §103 must be made explicit. *See* MPEP §2142. As will be discussed below, Applicants respectfully submit that the Office has not established a *prima facie* case of obviousness.

Specifically, Takahashi, Duhault, and Vaidyanathan cannot be relied upon to teach or suggest "the system control module, in response to receiving a user-specified title selection from the cursor button, is configured to control the decoder module controls the reproducing module to play back automatically a motion picture of the user-specified title *at*

user-specified scaled frame larger than the scale of a small frame used for title specification without receiving input for reproducing the user-specified title by the select button, if there is no button input for a select period of time, wherein the automatic play back start position of the user-specified title is a part of the moving picture which is indicated by the single frame, after receiving a user specified title *selected by the cursor button*, and wherein each of the single frames represent a portion of the moving picture,” as recited by claims 1 and 36. (emphasis provided). Claims 1 and 36 have been amended to further clarify Applicants’ position.

In contrast, Takahashi is silent regarding “the system control module, in response to receiving a user-specified title selection from the cursor button, is configured to control the decoder module controls the reproducing module to play back automatically a motion picture of the user-specified title *at user-specified scaled frame larger than the scale of a small frame used for title specification without receiving input for reproducing the user-specified title by the select button*, if there is no button input for a select period of time, wherein the automatic play back start position of the user-specified title is a part of the moving picture which is indicated by the single frame, after receiving a user specified title *selected by the cursor button*, and wherein each of the single frames represent a portion of the moving picture.” (emphasis provided).

The Examiner asserts that Takahashi discloses that after a user selects a chapter with the cursor button 27, that the associated moving picture may be displayed for a duration of time. However, Applicants believe this interpretation of Takahashi is incorrect. Takahashi only discloses playing back a moving picture for a period of time after receiving input for reproducing the moving picture by selection button. This is illustrated at col. 7, ll. 25-38 of Takahashi. Specifically, Takahashi discloses that “still pictures may be displayed in a sequence or alternatively a moving picture of *a predetermined duration may be displayed*.” (emphasis provided). In other words, Takahashi does not disclose “if there is no button input for a select period of time, wherein the automatic play back start position of the user-specified title is a part of the moving picture which is indicated by the single frame,” but instead shows a “preview” of the selected moving picture. The moving picture is not automatically played after a duration of time, but instead a duration of the movie is played as a preview of sorts.

Further, Applicants submit that Takahashi also fails to teach or suggest “user-specified scaled frame larger than the scale of a small frame used for title specification without receiving input for reproducing the user-specified title by the select button.”

Furthermore, Duhault and Vaidyanathan also fail to teach or suggest “the system control module, in response to receiving a user-specified title selection from the cursor button, is configured to control the decoder module controls the reproducing module to play back automatically a motion picture of the user-specified title *at user-specified scaled frame larger than the scale of a small frame used for title specification without receiving input for reproducing the user-specified title by the select button*, if there is no button input for a select period of time, wherein the automatic play back start position of the user-specified title is a part of the moving picture which is indicated by the single frame, after receiving a user specified title *selected by the cursor button*, and wherein each of the single frames represent a portion of the moving picture.” (emphasis provided).

As such, for at least these reasons, Applicants submit that Takahashi, Duhault, and Vaidyanathan, individually or when combined, fail to teach or suggest each and every element of claims 1 and 36. Therefore, Applicants respectfully request that this rejection be withdrawn.

Furthermore, claims 35 and 37-39 depend from independent claims 1 and 36. Thus, at least by virtue of their dependence on an allowable base claim, Applicants respectfully submit that claims 35 and 37-39 are also allowable. Thus, for at least this reason, Applicants respectfully request that this rejection be withdrawn.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

Further, the Commissioner is hereby authorized to charge any additional fees or credit any overpayment in connection with this paper to Deposit Account No. 20-1430.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,

/Charles W. Gray/

Charles W. Gray
Reg. No. 61,345

KILPATRICK TOWNSEND & STOCKTON LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 303-571-4000
Fax: 415-576-0300
CWG:l4b
63781579 v1